

REMARKS

The Office Action dated July 6, 2006, has been received and carefully considered. It is believed that the following remarks place the application in immediate condition for allowance. Accordingly, entry of this Amendment and favorable reconsideration of the application are respectfully requested.

I. **THE OBVIOUSNESS REJECTION OF CLAIMS 1-13, 14-19, 21-29, 31-54 AND 56-108**

On page 2 of the Office Action, claims 1-13, 14-19, 21-29, 31-54 and 56-108 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McMullin (U.S. Patent No. 6,222,914) in view of Reed (U.S. Patent No. 6,757,710). This rejection is hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Regarding independent claims 1, 23, 40, 63 and 87-89, the Examiner asserts that McMullin fails to explicitly teach designating a theme comprising a plurality of items offered by a plurality of providers wherein each item comprises at least one of a good and a service and each provider comprises one of a merchant and service provider. However, the Examiner asserts

that Reed makes up for McMullin's deficiency in this regard. The Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of McMullin to include designating a theme comprising a plurality of items offered by a plurality of providers wherein each item comprises at least one of a good and service and each provider comprises one of a merchant and service provider taught by Reed in order to bill a user for transactions for services and or goods provided and or ordered over the Internet."

However, Applicant respectfully submits that Reed does not teach or suggest "designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider," as recited in independent claim 1, for example.¹ First, Applicant respectfully submits that Reed merely discloses an automated communications system for transferring data, metadata from a provider computer to a consumer computer through a communications network. In particular, as described in Reed's Abstract, Reed relates to a method and apparatus for transferring information that controls a communication relationship so that changes in the provider computer are automatically updated in the consumer computer, and thus does not teach or suggest any feature or functionality that "designat[es] a theme comprising a plurality of items offered by a plurality of providers," as required by each of the independent claims:

An automated communications system operates to transfer data, metadata and methods from a provider computer to a consumer computer through a communications network. The transferred information **controls the communications relationship**, including responses by the consumer computer,

¹ Applicant respectfully submits that independent claims 23, 40, 63 and 87-89 recite similar language.

updating of information, and processes for future communications. Information which changes in the provider computer is automatically updated in the consumer computer through the communications system in order to maintain continuity of the relationship. Transfer of metadata and methods permits intelligent processing of information by the consumer computer and combined control by the provider and consumer of the types and content of information subsequently transferred. Object oriented processing is used for storage and transfer of information. The use of metadata and methods further allows for automating many of the actions underlying the communications, including communication acknowledgements and archiving of information. Service objects and partner servers provide specialized data, metadata, and methods to providers and consumers to automate many common communications services and transactions useful to both providers and consumers. A combination of the provider and consumer programs and databases allows for additional functionality, including coordination of multiple users for a single database.

See Reed Abstract (emphasis added). Applicant respectfully submits that the balance of Reed's specification similarly fails to teach or suggest the specific step of "designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider."

Second, Applicant respectfully submits that the Office Action's detailed description allegedly showing how Reed discloses the claim recitation does not in fact demonstrate any feature or functionality that even remotely relates to the step of "designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider." Rather, Applicant respectfully submits that the description provided in the Office merely demonstrates Reed relevance to the automatic updating of a database in a consumer computer with information from a provider computer, not the specific step of "designating a theme comprising a plurality of items offered by a plurality of providers," as required by each of the independent claims:

However Reed discloses a first embodiment of a system of the present invention which automatically updates a database in a consumer computer with information from a provider computer. Numerous providers and consumers exist in the system of the present invention. However, since all communications can be separated into transfers between a single provider and consumer, the design and operation of the system is illustrated with only one provider and one consumer, except as otherwise noted. As illustrated in FIG. 1, a provider computer 1 includes a provider database 11 of communications control information which it desires to disseminate or make accessible to one or more consumers. A consumer computer 2 includes a consumer database 21 of communications control information received from providers and stored by the consumer. The organization, structure, and content of the provider database 11 and consumer database 21 are discussed below. The provider computer 1 is connected, through a communications network 3 to the consumer computer 2. Any communications network 3 may be used to connect the provider computer 1 and the consumer computer 2, including direct network connections, server-based environments, telephone networks, the Internet, intranets, local area networks (LANS), wide area networks (WANS), the World Wide Web, other webs, and even transfers of data on physical media such as disks or computer-readable paper outputs via postal communications networks. The particulars of the communications network illustrated as preferred embodiments are not limiting features of the invention. However, the Internet and World Wide Web provide existing capabilities between computers sufficient to provide the necessary (See column 12 lines 1-65 and column 3-12 lines 1-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of McMullin to include designating a theme comprising a plurality of items offered by a plurality of providers wherein each item comprises at least one of a good and service and each provider comprises one of a merchant and service provider taught by Reed in order to bill a user for transactions for services and or goods provided and or ordered over the internet.

See Office Action, Pages 3-4.

Applicant is perplexed at how the above description of Reed demonstrates disclosure of the specific recitation “designating a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and each provider comprises at least one of a merchant and a service provider.” In particular, Applicant respectfully submits that the above description does not teach or suggest any feature or functionality that designates a theme, much less a theme comprising a plurality of items offered by a plurality of providers, wherein each item comprises at least one of a good and a service, and

each provider comprises at least one of a merchant and a service provider, as required by each of the independent claims. Accordingly, Applicant respectfully submits that the proposed combination of McMullin and Reed fails to teach or suggest each and every recitation of the pending independent claims.

Further, Applicant respectfully submits that the alleged motivation cited in the Office Action would not in fact motivate one of ordinary skill in the art to combine the references to achieve the claimed invention. First, McMullin relates to a system and method for administration of an incentive award system having a delayed award payment using a credit card, and thus would not benefit from -- and indeed has no need for -- Reed's method and apparatus for transferring data and metadata from a provider computer to a consumer computer to enable the automatic updating of the consumer computer. Second, even if the references were combined, they would not -- as set forth above -- achieve each and every recitation of the claimed invention. Accordingly, Applicant respectfully submits that independent claims 1, 23, 40, 63 and 87-89 are allowable over the cited references.

Claims 2-12, 14-19, 21-22, 24-29, 31-39, 41-54, 56-62, 64-86 and 90-108 are dependent upon independent claim 1, 23, 40, 63 or 87-89. Thus, since independent claims 1, 23, 40, 63 and 87-89 should be allowable as discussed above, claims 2-12, 14-19, 21-22, 24-29, 31-39, 41-54, 56-62, 64-86 and 90-108 should also be allowable at least by virtue of their dependency on independent claim 1, 23, 40, 63 or 87-89. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 91 recites "wherein the act of defining the thematic rewards program comprises: receiving a designation of the plurality of items, the designation of the plurality of items being consistent with a theme associated with the thematic rewards program."

Applicant respectfully submit that the cited references, alone or in combination, fail to teach or suggest the method of independent claim 89 wherein the act of defining the thematic rewards program comprises: receiving a designation of the plurality of items, the designation of the plurality of items being consistent with a theme associated with the thematic rewards program.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 1-13, 14-19, 21-29, 31-54 and 56-108 be withdrawn.

III. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

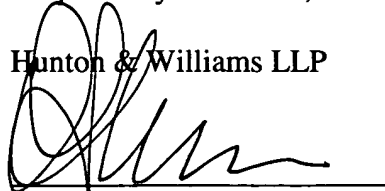
To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

Please charge any shortage in fees due in connection with the filing of this paper,
including extension of time fees, to Deposit Account No. 50-0206, and please credit any excess
fees to the same deposit account.

Respectfully submitted,

Hunton & Williams LLP

By:

A handwritten signature in black ink, appearing to read 'Ozzie A. Farres', written over a horizontal line.

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